

REMARKS

At the time of the Second Office Action dated September 14, 2010, claims 14, 21, 28, and 35-53 were pending and rejected in this application.

PRINCIPLES OF LAW

Examiner's Burden

The Examiner has the initial burden to set forth the basis for any rejection so as to put Appellants on notice of the reasons why Appellants are not entitled to a patent on the claim scope that Appellants seeks – the so-called "*prima facie* case." In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Additionally, the "[t]he examiner's action will be complete as to all matters," 37 C.F.R. § 1.104(b), and "[t]he pertinence of each reference, if not apparent, must be clearly explained." 37 C.F.R. § 1.104(c). Reference is also made to 37 C.F.R. § 1.2, which states "[t]he action of the Patent and Trademark Office will be based exclusively on the written record in the Office."

Anticipation

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single prior art reference. In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and

detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art. See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988). Under 35 U.S.C. § 102, not only must a prior art reference disclose all elements within a claim, the prior art reference must also disclose those elements "arranged as in the claim." Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383 (Fed. Cir. 2001); Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548 (Fed. Cir. 1983).

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. ... The second step in the analyses requires a comparison of the properly construed claim to the prior art." Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted). During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification," In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000), and the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). Therefore, the Examiner must

(i) identify the individual elements of the claims and properly construe these individual elements, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the remainder of the decisional process"), and

(ii) identify corresponding elements disclosed in the allegedly anticipating reference and compare these allegedly corresponding elements to the individual elements

of the claims. Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co.,
730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

**CLAIMS 14, 21, 28, 40, 46, AND 52 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING
ANTICIPATED BY DAN ET AL., U.S. PATENT NO. 6,148,290 (HEREINAFTER DAN)**

On pages 2-6 of the First Office Action, the Examiner asserted that Dan discloses the
invention corresponding to that claimed. This rejection is respectfully traversed.

In the first full paragraph on page 6 of the First Office Action, the Examiner presented
the following analysis:

creating said contract data comprising contract selection parameters for selecting at least
one service contract out of said plurality of contracts (col. 7, lines 24-47; "This registration prefer-
ably includes storing of a service contract identification number, information regarding the service
contract and the service contract itself.")

As claimed, the contract data comprises contract selection parameters, which given its broadest
reasonable interpretation consistent with Applicants' specification refers to parameters (i.e., a
plurality of parameters) used to select a contract. The only possible parameter described within
the Examiner's cited passage that could conceivably used to select a contract is the service
contract identification number. However, this service contract identification number regards a
contract that has already been selected. As stated in column 7, lines 27-32, the contract is first
created, and then registered. Thus, parameters identified by the Examiner are not used "for
selecting at least one contract out of said plurality of contracts," as claimed. Instead, these
parameters regarding a contract that has already been selected.

The above-reproduced arguments (incorporated herein) were previously presented on page 11, lines 7-22 of the First Response dated July 23, 2010 (hereinafter the First Response).

The Examiner's response to these arguments is

Specifically, applicant argues that the "parameters identified by Examiner are not used 'for selecting at least one contract out of said plurality of contracts' as claimed." Thus, applicant seems to be interpreting the claim as requiring selecting a contract. However, this is not required by the language of the claim. The claim's positive limitation is that contract data is being created. The part of the claim which states, "for selecting at least one service contract out of said plurality of contracts," is merely describing the contract data. It is not a positive claim limitation. Nowhere does the applicant state that any actual selecting of a contract takes place.

Applicants respectfully submit that the Examiner is imposing restrictions on the claim language that has no basis in law. Each and every word in a claim must be construed to have meaning. Exxon Chem. Patents, Inc. v. Lubrizol Corp., 64 F.3d 1553, 1557 (Fed. Cir. 1995), and ignoring a claim term constitutes clear legal error. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Therefore, the Examiner cannot choose to ignore certain limitations.

The Examiner's failure to give proper weight to the previously-presented claim limitations notwithstanding, Applicants note that independent claims 14, 21, and 28 have each been amended to clarify that the creation of the contract data comprises contract selections parameters, and these contract selection parameters are subsequently used for selecting at least one service contract out of a plurality of contracts. The "subsequently selecting ..." language is a limitation on the contract selection parameters being created, and this limitation cannot be ignored.

1 Additionally, Applicants note that independent claims 14, 21, and 28 have each been
2 amended to recite "receiving ... the service according to a selection of the at least one service
3 contract based upon the contract selection parameters." Thus, the service that is received has
4 been limited to a service that has been selected based upon the contract selection parameters,
5 which were created, as previously discussed.

6
7 The Examiner's requirement of "positive limitations" has no legal relevance regarding the
8 limitations in a claim. The hypothetical limitation of "a key configured to fit within XYZ lock"
9 does not require that the key actually be positioned within XYZ lock in order for the limitations
10 of "configured to fit within XYZ lock" be given patentable weight. The "configured to fit within
11 XYZ lock" is a limitation on the key regardless of whether or not the key is ever placed within
12 the lock. Similarly, the language of "for subsequently selecting at least one service contract out
13 of said plurality of contracts" places a limitation on the claimed "contract selection parameters,"
14 and the Examiner is not permitted to ignore these limitations.

15
16 Since Dan fails to teach the claimed "contract selection parameters," the Examiner has
17 failed to establish that Dan identically discloses the claimed invention, as recited in claims 14, 21,
18 28, 40, 46, and 52, within the meaning of 35 U.S.C. § 102. Applicants, therefore, respectfully
19 solicit withdrawal of the imposed rejection of claims 14, 21, 28, 40, 46, and 52 under 35 U.S.C. §
20 102 for anticipation based upon Dan.

CLAIMS 36, 42, AND 48 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON DAN

On pages 6-8 of the Second Office Action, the Examiner concluded that one having ordinary skill in the art would have considered the claimed invention to be obvious in view of Dan. This rejection is respectfully traversed.

Claims 36, 42, and 48 respectively depend from independent claims 14, 21, and 28, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 14, 21, and 28 under 35 U.S.C. § 102 for anticipation based upon Dan. Applicants, therefore, respectfully submit that the imposed rejection of claims 36, 42, and 48 under 35 U.S.C. § 103 for obviousness based upon Dan is not viable, and hence, Applicants solicit withdrawal thereof.

CLAIM 35 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON DAN IN VIEW OF REID ET AL., U.S. PATENT PUBLICATION NO. 2002/0178120 (HEREINAFTER REID)

On pages 8-10 of the Second Office Action, the Examiner concluded that one having ordinary skill in the art would have considered the claimed invention to be obvious in view of Dan and Reid. This rejection is respectfully traversed.

Referring to the first two full paragraphs on page 10 of the Second Office Action, the Examiner asserted the following:

Dan discloses a service contract system for providing a service over a network. Dan does not explicitly disclose selecting one particular contract according to said evaluation and further selection logic.

However, Reid teaches a similar system for managing contracts. Reid teaches selecting one particular contract according to said evaluation and further selection logic (paragraph 35;

1 "...allows a user to search for agreements based on several fields including but not limited to:
2 agreement number..." (emphasis added)
3

4 Referring to the underlined portions of the above-reproduced passage, the Examiner
5 correctly notes that Dan does not teach selecting a particular contract according to the evaluation
6 and further selection logic. However, when referring to Reid, the Examiner's cited passage does
7 not refer to selecting. Instead, Reid teaches searching for agreements. Searching for an
8 agreement is entirely different than selecting an agreement. For example, the search for an
9 agreement may not yield any agreement or even if the search does yield one or more agreements,
10 these agreements may not be selected.
11

12 Moreover, the searching for agreements by Reid does not employ "evaluation and further
13 selection logic," as claimed. Instead, Reid teaches that the searching is based upon the, by a
14 user, of data in certain search fields (e.g., "agreement number, agreement type ..." etc.). Thus,
15 the Examiner has mischaracterized the scope and content of Reid. Applicants, therefore,
16 respectfully submit that the imposed rejection of claim 35 under 35 U.S.C. § 103 for obviousness
17 based upon Dan in view of Reid is not viable, and hence, Applicants solicit withdrawal thereof.
18

19 **CLAIMS 37-39, 43-45, AND 49-50 ARE REJECTED UNDER 35 U.S.C. § 103 FOR**
20 **OBVIOUSNESS BASED UPON DAN IN VIEW OF "SOAP VERSION 1.2" (HEREINAFTER SOAP)**

21 On pages 10 and 11 of the Second Office Action, the Examiner concluded that one having
22 ordinary skill in the art would have considered the claimed invention to be obvious in view of Dan
23 and Soap. This rejection is respectfully traversed.
24

Claims 37-39, 43-45, and 49-50 respectively depend from independent claims 14, 21, and 28, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 14, 21, and 28 under 35 U.S.C. § 102 for anticipation based upon Dan. The secondary reference to Soap does not cure the argued deficiencies of Dan. Accordingly, even if one having ordinary skill in the art did modify Dan in view of Soap, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claims 37-39, 43-45, and 49-50 under 35 U.S.C. § 103 for obviousness based upon Dan in view of Soap is not viable, and hence, Applicants solicit withdrawal thereof.

CLAIMS 41, 47, AND 52 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON DAN IN VIEW OF LAMB ET AL., U.S. PATENT PUBLICATION NO. 2005/0198111 (HEREINAFTER LAMB)

On pages 11 and 12 of the Second Office Action, the Examiner concluded that one having ordinary skill in the art would have considered the claimed invention to be obvious in view of Dan and Lamb. This rejection is respectfully traversed.

Claims 41, 47, and 52 respectively depend from independent claims 14, 21, and 28, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 14, 21, and 28 under 35 U.S.C. § 102 for anticipation based upon Dan. The secondary reference to Soap does not cure the argued deficiencies of Dan. Accordingly, even if one having ordinary skill in the art did modify Dan in view of Soap, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that

1 the imposed rejection of claims 37-39, 43-45, and 49-50 under 35 U.S.C. § 103 for obviousness
2 based upon Dan in view of Soap is not viable, and hence, Applicants solicit withdrawal thereof.

3

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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